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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,678	11/09/2001	Markus Andreasson	3782-0194P	5810

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EXAMINER

CHOOBIN, BARRY

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/986,678 ✓

Applicant(s)

ANDREASSON, MARKUS

Examiner

Barry Choobin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-8,10,11 and 13-15 is/are rejected.
- 7) ☒ Claim(s) 2, 5, 9, 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see REMARKS, filed 12/22/2004, with respect to the rejection(s) of claim(s) 1-15 under 35 U.S.C 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wolff et al (applicant's admitted prior art) and Krasuski et al.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-4, 6-8, 10-11, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff et al in view of Krasuski et al (US 2001/0032033).

As to claim 1, Wolff et al disclose a method for remote addressing of an item of mail (column 1, line 50 - column 2, line 12, comprising obtaining remotely produced address information (column 2, lines 1-2), the address information comprising a digitally represented graph of a handwritten address (column 2, lines 1-12).

However, Wolff et al does not expressly disclose that the graph is applied to the item of mail.

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Krasuski et al (US 2001/0032033) disclose a system for preparing mail items comprising a printer for printing all the necessary information on the envelope, in particular the destination address and the of the postage or "postage imprint", corresponding to the applying a graph to the mail item in claim 1 (page 1, paragraph 0006).

Krasuski et al and Wolff et al are combinable because they both are from similar problem solving area of automating a process for preparing an item (newspaper, advertisement, magazine, envelope, etc) for sending to a destination address.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify Wolff et al with the printing address information on an envelope in a full automatic way as disclosed by Krasuski et al (page 1, paragraph 0006).

The motivation/suggestion for doing so would have been to offer a system that is completely self-contained and that prepares mail item fully, ready for posting (page 1, paragraph 0001 of Krasuski et al).

Therefore, it would have been obvious to combine Krasuski et al with Wolff et al to obtain the invention as specified in claim 1.

As to claim 3, Wolff et al disclose address information is obtained via at least one wireless interface from a Mobile communication unit (abstract).

As to claim 4, Wolff et al disclose address information is obtained from a digitizing pen (fig.6).

As to claim 6, Krasuski et al disclose applying of the address information to the item of mail comprises causing a printer to print out the address information on an address label, envelope, etc (page 1, 0006).

As to claim 7, Wolff et al et al disclose a computer program stored on a program medium comprising program instructions for implementing a method as claimed in claim 1 or 2 (see claim 1).

As to claim 8, all the limitations of this claim are addressed in claim 1 and as to a device versus a method, Wolff et al disclose a device and method for communication and Krasuski et al disclose a system for preparing mail item (see the title of the inventions).

As to claims 10, 11, 13, theses claims respectively are addressed by claims 3, 4, 6.

As to claim 14, Wolff et al disclose a storage medium containing software comprising program instructions for implementation of a method as claimed in claim 1 or 2 (see claim 1).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter. Claim 15, recites a computer program to carry out a method.

A computer program by itself has no set definition. A statutory product with descriptive material must include a positive recitation of the computer readable medium -- MPEP 2106.

Allowable Subject Matter

5. Claims 2, 5, 9, 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

6. This action is non-final.

CONTACT INFORMATION

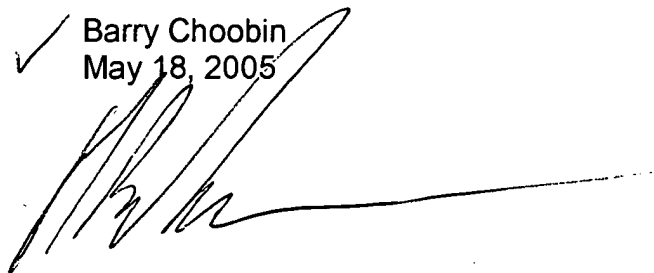
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barry Choobin whose telephone number is 571-272-7447. The examiner can normally be reached on M-F 7:30 AM to 18:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on 571-272-7453. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

✓ Barry Choobin
May 18, 2005

A handwritten signature in black ink, appearing to read 'Barry Choobin', followed by a long horizontal line extending to the right.